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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,783	01/24/2000	Richard C. Johnson	ORCL5628	7640

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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT PAPER NUMBER

3626

MAIL DATE DELIVERY MODE

07/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/490,783	JOHNSON, RICHARD C.	
	Examiner	Art Unit	
	Luke Gilligan	3626	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: NONE.
- Claim(s) objected to: NONE.
- Claim(s) rejected: 1-4, 7-10 and 13-16.
- Claim(s) withdrawn from consideration: NONE.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.


C. LUKE GILLIGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

Response to Arguments

Continuation of Section 11: In the remarks filed 6/26/07, Applicant argues in substance that (1) the proposed combination of Shub and Kadaba would render Shub unsatisfactory for its intended purpose and impermissibly change its principle of operation; (2) there is no teaching or suggestion in Shub to aggregate the 1st and 2nd clearinghouses with the 1st and 2nd carriers; (3) the alternative embodiments described by Shub do not teach certain claim limitations.

In response to Applicant's argument (1), as noted by the Applicant, the teachings of Kadaba have been relied upon to teach that a single carrier may include a plurality of clearinghouses or hubs and use a plurality of "shippers" in the process of delivering a shipment from an origin to its final destination. In such a scenario, although the carrier is made up of a plurality of entities (multiple clearing houses and multiple "shippers"), collectively, these multiple entities may be construed as a single carrier such as UPS. Therefore, under this scenario, the process described by Shub would still take place exactly as described but any communication to or from a clearinghouse of the carrier or a "shipper" of the carrier could be fairly construed as being to or from the single carrier such as UPS. Furthermore, under this scenario, the carrier would still not have complete knowledge of the transaction. It does not appear that any of the clearinghouses or "shippers" are given the customer's name, only the address of the customer. It also does not appear that the clearinghouses or "shippers" are given any information identifying the goods that have been purchased, only the cost of the transaction. Indeed, Shub states that nobody knows both the identity of the customer and what is bought in the transaction (see column 2, lines 9-11). In addition, Applicant has not pointed to any portion of Shub that discloses any combination of the clearinghouses and shippers being given the identity of the customer and/or the identity of what was bought in the transaction. Accordingly, the Examiner

Art Unit: 3626

cannot agree that the proposed combination renders Shub unsatisfactory for its intended purpose or impermissibly changes its principle of operation.

It should also be noted that Applicant's arguments against Shub are quite different from cases cited in support thereof. For example, it would not be obvious to turn a strainer for removing dirt and water from gasoline upside down because, by doing so, dirt and water would no longer be removed. On the other hand, the proposed modification to Shub still clearly results in the customer's package being delivered to the customer and, as shown above, certain information from the transaction is still protected. The Examiner is not suggesting a modification in which the customer's package is never delivered or certain steps cannot be carried out.

In response to Applicant's argument (2), the Examiner agrees that Shub does not explicitly teach that one could embody the clearinghouses and shippers in a single carrier such as UPS. However, "a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Nevertheless, the Examiner respectfully submits that the proposed combination of Shub and Kadaba naturally flows from the teachings of Shub, given the level of ordinary skill in the art. In particular, Shub suggests that "there is a need for making sure that all services and goods are paid for in a secure way and orders can be confirmed, without much alteration to traditional distribution channels which have proven efficient and with which most merchants feel comfortable (see column 1, lines 45-50). Additionally, Shub suggests that an object of the invention is "to be operable with existing commercial distribution channels, with which

Art Unit: 3626

merchants are already familiar (see column 1, lines 65-67). Therefore, Shub clearly suggests that the invention be embodied in established distribution channels, such as UPS.

In response to Applicant's argument (3), the Examiner agrees with Applicant that alternative embodiments of Shub do not teach certain claim limitations. However, since the Examiner has not relied upon these alternative embodiments, this argument is not found to be persuasive.